REMARKS:

The amendment to the specification is identical to that set forth in the amendment filed on February 24, 2004 (but apparently not entered). The amendment is made to describe originally filed Figs. 3 and 4. No new matter is added since the new text merely adds references to features shown in originally filed Figs. 3 and 4 (which are described in the originally filed "Brief Description of Drawings" section on page 4 of the specification). Attached is a copy of the return postcard submitted with the amendment filed on February 24, 2004, and returned to the undersigned attorney with a stamp evidencing that the amendment was received by the USPTO on February 27, 2004.

Claims 5-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,918,217 (Maggioncalda). In response, Applicant contends for the following reasons that the rejected claims are patentable over the cited reference.

Claim 5 recites a processor programmed to perform an arithmetic performance attribution computation of a specifically recited type, including by determining coefficients $(A+\alpha_t)$ of the specifically recited type, and determining portfolio relative performance in the specifically recited way using these coefficients.

Claim 6 recites a processor programmed to perform a geometric performance attribution computation of a specifically recited type, including by determining attribution effects for issue selection $(1+I_{it}^{G})$ of the specifically recited type, determining attribution effects for sector selection $(1+S_{it}^{G})$ of the specifically recited type, and determining portfolio performance in the specifically recited way using these attribution effects.

Claim 7 recites a computer readable medium which stores code for programming a processor to perform an arithmetic performance attribution computation of a specifically recited type, including by determining coefficients $(A+\alpha_t)$ of the specifically recited type, and determining portfolio relative performance in the specifically recited way using these coefficients.

Claim 8 recites a computer readable medium which stores code for programming a processor to perform a geometric performance attribution computation of a specifically recited type, including by determining attribution effects for issue selection $(1 + I_{it}^{G})$ of the specifically recited type, determining attribution effects for sector selection $(1 + S_{it}^{G})$ of the specifically recited type, and determining portfolio performance in the specifically recited way using these attribution effects.

Maggioncalda fails to teach or suggest a processor programmed to perform any arithmetic (or geometric) performance attribution computation, and fails to teach or suggest a processor programmed to perform the operations specifically recited in claim 5 or 6. Maggioncalda also fails to teach or suggest a computer readable medium which stores code for programming a processor to perform any arithmetic (or geometric) performance attribution computation, and fails to teach or suggest a computer readable medium which stores code of the type specifically recited in claim 7 or 8.

The assertion on page 3 of the Office Action that the "claimed invention recites an intended use" of a processor is incorrect to the extend that it implies that claim 5 or 6 reads on a computer system including a processor (e.g., an unprogrammed processor) that is not programmed to perform the recited operations but is capable of being programmed to perform such operations, and a display device coupled to the processor. Such broad construction of claims 5 and 6 is overbroad since it ignores the explicit limitation in each of claims 5 and 6 of a processor that has been programmed to perform specifically recited operations. Neither of claims 5 and 6 is intended to read on a computer system that does not include a processor programmed as recited.

The assertion on page 3 of the Office Action that the "claimed invention recites an intended use" of a processor is also incorrect to the extent that it implies that claim 7 or 8 reads on a computer readable medium which does not store code for programming a processor to perform the recited performance attribution computation but is capable of storing such code. Such broad construction of claims 7 and 8 is overbroad since it ignores the explicit limitation in each of claims 7 and 8 of a computer readable medium that does store code of the specifically recited type. Neither of claims

7 and 8 is intended to read on a computer readable medium that does not store code of the specifically recited type.

Applicant also contends that the rule (cited in the Office Action) that "recitation of a new intended use for an old product does not make a claim to that old product patentable" does not provide a basis for rejecting any of the claims. None of claims 5, 6, 7, and 8 is directed to an "old" product or recites a new use for an old product. Rather, each of claims 5-8 recites a new product (namely, a computer system including a processor that has been programmed in a new way, or a computer readable medium that stores code of a new type). A programmable processor (e.g., the CPU of a personal computer) has a physically different state when it has been programmed as recited in claim 5 or 6, than when it has not been so programmed. Thus, the recited processor is a new product when it has been so programmed (in contrast with an "old" processor that has a different physical state than the recited processor because it has not been so programmed). Similarly, a computer readable medium that stores code of a specific type has a physically different state than when it does not store such code. Thus, the recited computer readable medium is a new product when it stores such code (in contrast with an "old" medium that has a different physical state than the recited medium because it does not store the recited code).

Applicant respectfully contends that the assertion in the Office Action that Maggioncalda discloses (e.g., at column 6, lines 25-42) a processor "programmed to perform an arithmetic performance attribution computation to determine portfolio performance" is incorrect. Rather, there is no teaching determinable from Maggioncalda, at column 6, lines 25-55, or elsewhere, of a processor programmed to perform such an operation or that it would be desirable to so program a processor. The only teachings in Maggioncalda regarding how to program a processor are teachings to program a processor to perform operations very different from those recited in any of claims 5-8. For example, Maggioncalda teaches programming a processor to perform computations such as determining a recommended set of financial products (e.g., the products indicated in region 430 of Maggioncalda's Fig. 4) for achieving user-specified financial goals, and "constraining settings associated with... [a] graphical input mechanism" in response to a user-specified "desired level of investment risk," and determining an indication (e.g., the indications shown in

Maggioncalda's Fig. 7c) of the probability of achieving a user-specified financial goal. There is no teaching or suggestion determinable from Maggioncalda of a processor programmed to perform the specific operations recited in claim 5 or 6, or of a computer readable medium that stores code of the type specifically recited in claim 7 or 8.

Nor is there a basis determinable from a reference of record for the assertion in the Office Action that Maggioncalda's computer system is "capable of performing an arithmetic performance attribution computation" of the type recited in each rejected claim. Rather, this assertion is incorrect. In order for Maggioncalda's computer system to have the asserted capability, the processor of such system would need to be programmed to perform the arithmetic performance attribution computation. Maggioncalda fails to teach or suggest how to so program a processor, or that it would be desirable to so program a processor. Absent teaching determinable from art of record to program a processor to perform the operations recited in claim 5, 6, 7, or 8, it is improper to reject claim 5, 6, 7, or 8 on the basis of an unsupported assertion that "it would have been obvious" to program Maggioncalda's processor to perform such operations.

Further, even assuming for the sake of argument that Maggioncalda's computer system is capable of performing an arithmetic performance attribution computation (if programmed to do so), there is no basis determinable from Maggioncalda for rejecting claim 7 or 8 since each of these claims recites a processor programmed to perform a geometric performance attribution computation (i.e., the specifically recited geometric performance attribution computation) or a computer readable medium that stores code for so programming a processor.

Further, even assuming for the sake of argument that Maggioncalda's computer system is capable of performing an arithmetic performance attribution computation (if programmed to do so), there is no basis determinable from Maggioncalda for rejecting claim 5, since claim 5 recites a processor programmed to perform an arithmetic performance attribution computation of a specifically recited type and Maggioncalda neither teaches nor suggests programming a processor to perform this specifically recited computation. The Examiner has not identified any such specific

teaching or suggestion in Maggioncalda, and instead apparently relies improperly on the unsupported assertion that it "would have been obvious" to program Maggioncalda's processor to perform the recited operation.

Reconsideration and allowance of claims 5, 6, 7, and 8 is respectfully requested.

Respectfully submitted,

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